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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,062	08/20/2003	Takeki Shirai	030932	4354

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EXAMINER
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HAMLIN, DERRICK G

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/644,062

**Applicant(s)**

SHIRAI ET AL.

**Examiner**

Derrick G. Hamlin

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 4 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-7 are currently pending.

The rejection of claim 3-6, under 35 U.S.C. 112, second paragraph, is withdrawn in view of the applicant's amendment filed 2/22/05.

The rejection of claim 2, under 35 U.S.C. 102(b) as being anticipated by Uekusa et al. (US 5387360 A), is withdrawn in view of the applicant's amendment filed 2/22/05.

The rejection of claim 1, under 35 U.S.C. 102(b) as being anticipated by Uekusa et al. (US 5387360 A), is maintained for the reasons set forth in the office action mailed 10/20/04.

Claims 1 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable Ehrhardt et al.

### ***Claim Rejections - 35 USC § 112***

Claims 2 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board

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of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). For example in the present instance, claims 2 and 7 recites the broad recitation a surface activating agent, and the claim also recites specific types which is the narrower statement of the range/limitation.

### ***Specification***

Claims 2 and 7 are objected to because of the following informalities: Both claims enclose the Markush groups in parenthesis instead of using the claim language, "selected from the group". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claim 1, under 35 U.S.C. 102(b) as being anticipated by Uekusa et al. (US 5387360 A), is maintained for the reasons set forth in the office action mailed 10/20/04. Applicant argues that the reference teaches an engine coolant and not a

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machine coolant. It is the examiners position that the limitation is in the preamble and should not be given patentable weight. Furthermore, the limitation of being a machine coolant would clearly be commensurate in scope with an engine coolant, as an engine is clearly a machine.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable Ehrhardt et al. (US 6585933 A). Ehrhardt discloses a method for controlling the corrosion of metals in contact with an aqueous system at a pH of about 5 to about 12 which comprises introducing into said system a combination of: (a) a tetrazolium compound and (b) at least one other aqueous system treatment material chosen so that the material such as polymeric amine oxides; amines, diamines; alkanolamines; fatty amines and diamines; quaternized amine and amine salts of carboxylic acids; water soluble salts thereof and mixtures thereof, wherein the weight ratio of component (b) to component (a) is from about 100:1 to about 1:20. (col. 26, line 64- col. 27, line 43) The nitrite may be sodium nitrite. (col. 28, lines 16-17) The composition was tested on a carbon steel (col. 19, lines 1-2) and additional agents that may be combined with the tetrazolium compounds of this invention include freezing point depressants. Such agents are needed for aqueous systems such as refrigeration, dehumidification, and

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internal combustion engine coolant systems, such as sodium chloride, glycols and and other alcohols (col. 14, lines 45-55).

Ehrhardt fails to teach that a machine device made of carbon steel is coated with the instantly claimed coolant.

Although the reference fails to specifically teach that a machine device <sup>made</sup> ~~mad~~ of carbon steel is coated with the instantly claimed coolant, it does teach that that the composition is useable in a an engine coolant and on metals such as carbon steel. Therefore it would have been in the preview of the skilled artisan at the time the invention was made to use the instantly claimed composition in an engine as a coolant when the engine is made of carbon steel.

In view of the forgoing, the above claims have failed to be patently distinguishable over prior art.

### ***Allowable Subject Matter***

Claims 3 and 4 are allowed. None of the references cited teach or suggest the use of a coolant comprising 0.1 M NaCO<sub>3</sub> with 0.01 M NaCl in 2 % of a coolant or surfactant and sodium nitrate in the instantly claimed amounts.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a): Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick G. Hamlin whose telephone number is (571) 272-1317. The examiner can normally be reached on Monday-Fridays from ~8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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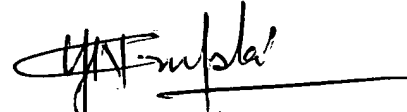
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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick G. Hamlin

5/31/05



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